

REMARKS

Reconsideration and withdrawal of the requirement for restriction are respectfully requested in view of the remarks herewith.

The October 3, 2003 Office Action required an election under 35 USC § 121 from:

Group I Claims 1-19, 39, and 48, which are drawn to methods for treating subsurface tissue classified in class 606, subclass 9;

Group II Claims 20-38, 46, 47, 49, and 50 which are drawn to apparatus for non-invasive treatment tusses, classified in class 606, subclass 10; and

Group III Claims 40-45, drawn to computer/control program instructions for controlling the operations of a laser beam, classified in class 700, subclass 166.

In response to the Restriction Requirement, Group II, claims 20-38, 46, 47, 49, and 50, is provisionally elected, with traverse.

This election is made with traverse and without prejudice to Applicants' right to file divisional applications directed to the non-elected subject matter. It is respectfully requested that the restriction requirement be favorably reconsidered and withdrawn.

It is respectfully urged that the Restriction Requirement does not establish that searching all the inventions would constitute an undue burden to the Patent Office. Moreover, Applicants urge that the Restriction Requirement is contrary to public policy. Accordingly, it is respectfully submitted that the Restriction Requirement is improper and should be withdrawn or at least modified.

The MPEP lists two criteria for a proper restriction requirement. First, the invention must be independent or distinct. MPEP § 803. Second, searching the additional invention must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application "[i]f the search and examination of an

entire application can be made without serious burden, ... even though it includes claims to distinct or independent inventions." *Id.*

It is respectfully asserted that the Restriction Requirement does not meet the second of these criteria as the searches for Groups I, II, and III overlap. For example, the claims of Groups I and II share the same class and as stated in the Office Action are related process and apparatus for its practice. Further, the steps of claims 1, 39 and 48 specify the utilization of the apparatus elements as recited in claim 20. Accordingly, the Restriction Requirement, it is respectfully submitted, should be at least modified to combine the claims of Groups I and II for prosecution on the merits in one application.

It is also respectfully submitted that the present claims represent a web of knowledge and continuity of effort that merits examination in a single application. Therefore, reconsideration and modification of the Restriction Requirement are warranted.

Further still, it is respectfully urged that restricting the claims in the manner suggested in the restriction requirement, constitutes an undue burden to Applicants as well as the public. Hence, it is against public policy. If followed, the restriction requirement would require Applicants to file additional applications depending on how the Examiner maintains these requirements. The cost of prosecuting and maintaining additional patents is unreasonable in view of the fact that the application as filed includes claims that are, as set forth in the restriction requirement, related to one another. Further, under GATT, the period of exclusivity for any patents which issue from these divisional applications is greatly reduced. Similarly, the public is inconvenienced, as they will not know whether or not Applicants will file divisional applications to the remaining subject matter. Accordingly, the public will not know if they can practice the remaining invention without infringing future patent applications.

Accordingly, it is respectfully maintained that, given the absence of serious burden on the Examiner in examining the claims and claimed subject matter together, and the significant negative consequences to the Applicants and the public in having the claims examined separately, the restriction requirement should be reconsidered and withdrawn, and that all of the claims and all of the claimed subject matter be examined in this one application. Or in the alternative, at least modified to combine the claims of Groups I and II for prosecution on the merits in one application. Such relief is respectfully requested.

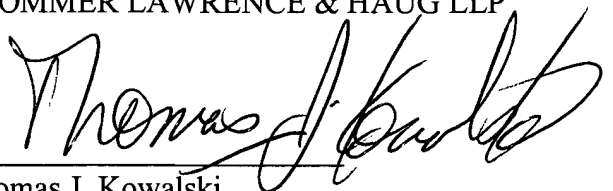
Accordingly, in view of the foregoing, reconsideration and withdrawal of the restriction requirement are requested, and an early action on the merits is earnestly solicited.

Any fee occasioned by this paper, may be charged, or overpayment credited to, Deposit Account No. 50-0320.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP

By:


Thomas J. Kowalski
Reg. No. 32,147
(212) 588-0800